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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,256	07/24/2003	Michael Gerhard Hoffman	09879-00033-US AGR2002/M2	4185
23416	7590	11/20/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			RAO, DEEPAK R	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 11/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/627,256	HOFFMAN ET AL.	
	Examiner	Art Unit	
	Deepak Rao	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 15 are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 15 are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20030724</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-12 and 14-15 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

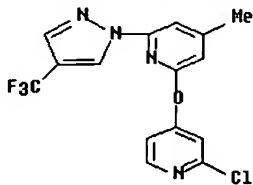
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Maier et al., CAPLUS Abstract 134:366871 (2001). The instantly claimed compounds read on reference disclosed herbicidal compounds, see the compounds having RN 340690-15-5; 340690-16-6; 340690-18-8; 340690-19-9; and 340690-20-2 (some of the reference compounds depicted below for convenience):

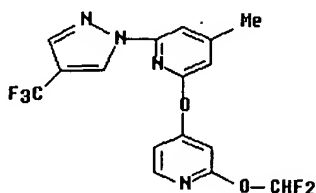
RN 340690-15-5 CAPLUS

CN Pyridine, 2-[(2-chloro-4-pyridinyl)oxy]-4-methyl-6-[4-(trifluoromethyl)-1H-pyrazol-1-yl]- (9CI) (CA INDEX NAME)



RN 340690-16-6 CAPLUS

CN Pyridine, 2-[[2-(difluoromethoxy)-4-pyridinyl]oxy]-4-methyl-6-[4-(trifluoromethyl)-1H-pyrazol-1-yl]- (9CI) (CA INDEX NAME)



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier et al., EP 1101764 (05-2001). The reference teaches 6-pyrazol-1-yl-pyridine compounds that are structurally analogous to instantly claimed compounds. See the compounds represented by formula (I) in page 2 and the corresponding Examples 1-6 disclosed in pages 9-10. The compounds are taught to be useful as herbicidal agents, see page 10. The instant compounds differ from the reference compounds by having the trifluoromethyl (CF₃) group at a position different from the reference compounds, i.e., at the 4-position of the pyrazol-1-yl group as compared to the 3-position for the reference disclosed compounds. Therefore, the instantly claimed compounds are positional isomers of the reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly

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claimed compounds because they are positional isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as herbicidal agents. It has been held that a compound, which is structurally isomeric with a compound of prior art is *prima facie* obvious absent unexpected results. *In re Finley*, 81 USPQ 383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

2. Claims 1-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selby et al., WO 98/40379 (1998). The reference teaches 6-pyrazol-1-yl-pyridine or 6-pyrazol-1-yl-pyrimidine compounds that are structurally analogous to instantly claimed compounds. See the compounds represented by formula I in page 2 and the corresponding Examples in Tables 1-5 wherein W is CH or N; X is N and Y and Z are CH. The compounds are taught to be useful as herbicidal agents, see pages 31-36. The instant compounds differ from the reference compounds by having the trifluoromethyl (CF₃) group at a position different from the reference compounds, i.e., at the 4-position of the pyrazol-1-yl group as compared to the 3-position for the reference disclosed compounds. Therefore, the instantly claimed compounds are positional isomers of the reference compounds. Further, the reference teaches the equivalency of the 3- and 4-positions as X and Y both are defined to represent either N or C, thus establishing the equivalency of the ring positions. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are positional isomers of the

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reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as herbicidal agents. It has been held that a compound, which is structurally isomeric with a compound of prior art is *prima facie* obvious absent unexpected results. *In re Finley*, 81 USPQ 383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-12 and 14-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 11/077,110. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compounds of each of the application are structurally analogous. The reference claims are drawn to pyrimidine compounds having a -O-Y radical at the 2-position and a 4-CF₃-pyrazol-1-yl group at the 4-position. The instant claims differ by reciting compounds wherein the -O-Y group is at the 4-position and the 4-CF₃-pyrazol-1-yl group at the 3-position. In other words, the positions of the substituent groups are interchanged and therefore, the compounds in the copending applications are structurally analogous to each other. Further, both the reference compounds and the instant compounds are disclosed to have the same use, i.e., as herbicidal agents. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are structurally analogous to the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such analogous compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as herbicidal agents. It has been held that a compound, which is structurally isomeric with a compound of prior art is prima facie obvious absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Receipt is acknowledged of the Information Disclosure Statement filed on July 24, 2003 and a copy is enclosed herewith.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

November 15, 2006